

Serial No. 10/710,307  
Attorney Docket No. 70655.1300

### **REMARKS**

Applicants reply to the Office Action mailed on October 10, 2006 within two months. Thus, Applicants request an Advisory Action, if necessary. Claims 1-20 were pending and the Examiner rejects claims 1-20. In reply, Applicants amend claims 1, 3, 7, 16, 18 and 20, add claims 22-24, cancel claims 6, 10 and 11 without prejudice to filing one or more claims having similar subject matter, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, and therefore, Applicants have complied with 37 C.F.R. § 1.56.

### **DOUBLE PATENTING REJECTION**

Claims 1 and 3 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 20 of copending App. No. 10/710,332. Applicants assert that the amendments to claims 1 and 3 render this provisional rejection moot and respectfully request withdrawal of the rejection.

### **35 U.S.C. § 103 (a) REJECTIONS**

Claims 1-13, 15, 17-19 and 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Black, U.S. Pub. No. 2005/0122209 ("Black") in view of Hohle et al, U.S. Pat. No. 6,101,477 ("Hohle"). Claims 14 and 19 stand rejected as unpatentable over Black/Hohle in view of de Sylva, U.S. Pub. No. 2005/0098621 ("de Sylva"). Claim 14 stands rejected as unpatentable over Black/Hohle in view of Moebs U.S. Pub. No. 2005/0065872 ("Moebs"). Claim 16 stands rejected as unpatentable over Black/Hohle in view of de Goodman, U.S. Pub. No. 2002/0043566 ("Goodman"). Claim 19 stands rejected as unpatentable over Black Hohle in view of Jensen et al., U.S. Pub. No. 2005/0165684 ("Jensen"). Applicants respectfully traverse these rejections.

Applicants' amendment to independent claim 1 renders these rejections moot. Black discloses various combined biometric authorizations for transactions, e.g., signature and fingerprint verification. Hohle discloses a smartcard for storing travel-related information.

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Thus, while Black and Hohle together disclose various smartcard and biometric technologies useful in transactions, neither Black, Hohle, nor any combination thereof, disclose or suggest at least a smartcard transaction system "configured to use said data representing said proffered biometric sample as a variable in an encryption calculation to secure at least one of user data and transaction data," as recited in amended claim 1.

Accordingly, Applicants assert that claim 1 is patentable over the cited references. Similarly, claims 2-20 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2-20 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features.

For example, neither Black, Hohle, nor any combination of thereof, disclose or suggest at least a smartcard transaction system "configured to use said data representing said proffered biometric sample as at least one of a private key and a public key to facilitate encryption security associated with said transaction" as recited in amended claim 3. Similarly, neither Black, Hohle, nor any combination of thereof, disclose or suggest at least a smartcard transaction system "configured to use said data representing said proffered biometric sample in generating a message authentication code" as recited in claim 7.

The amendments to the claims are supported in the specification by at least paragraphs [00331-00332]:

[00331] In another exemplary embodiment of the present invention, one or more biometric samples may be used to sign and/or encrypt information. For example, smartcard 100 and/or reader 2500 may be configured to receive a biometric sample from a user. The sample may then be digitized and used, for example, as a variable in an encryption calculation to secure data. If the user wants to retrieve the encrypted data, the user must submit the relevant biometric sample and have it authenticated by any of the methods described herein. Once the biometric sample is authenticated, the data will be decrypted for access.

[00332] Similarly, a biometric may be used as both a private key and a public key for encryption purposes. In one exemplary embodiment, an entity may use stored biometric sample information to encrypt data in a manner similar to a public key. The data may then be configured such that it is only accessible by a real biometric sample, for example, by a user proffering a

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fingerprint sample at a reader. Upon verification of the real biometric sample, the data may be decrypted and/or retrieved.

Additional support is found in at least paragraphs [00138-00146, 00249, 00253, 00316, and 00320]

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-20.

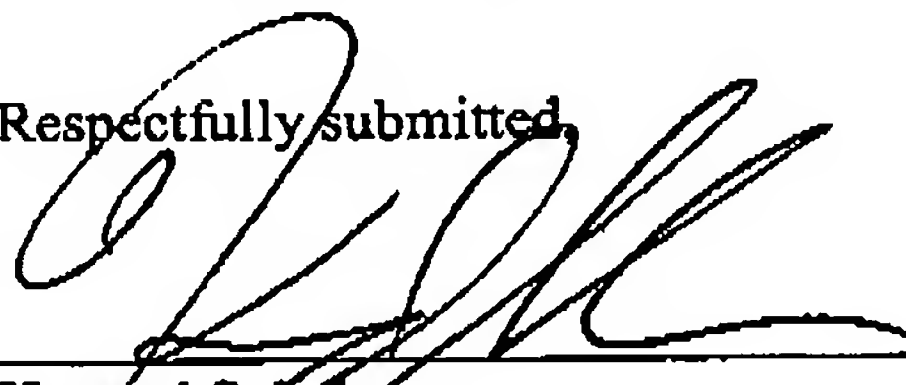
#### New Claims 22-24

Applicants assert that new claims 22-24 are differentiated from the cited references at least for the same reasons as set forth above with respect to claim 1, in addition to their own respective features

#### CONCLUSION

Applicants respectfully submit that the pending claims (21 total, 2 independent) are in condition for allowance. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

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